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GHC11USA



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No. : 09/743,818 Confirmation No.: 8602
Applicant : Weiss et al.
Filed: April 26, 2001
TC/A.U. : 1653 **RECEIVED**
Examiner : H. Schnizer **MAY 10 2004**
Customer No. : 00270 **TECH CENTER 1600/2900**
Title : PROTEASE SUSCEPTIBILITY II

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.181

Sir:

Applicants respectfully petition the Director of the US Patent and Trademark Office to accept entry of the enclosed Response. Pursuant to 37 CFR § 1.181(d) and (e), Applicants have included a statement of the facts and the required fee under 37 CFR § 1.17(h) of \$130.00.

The statement of the facts is the following.

Express Mail No. EU531570933US

(i) On October 27, 2003, Applicants forwarded the following documents to the US Patent and Trademark Office (USPTO) by US Express Mail service:

- (a) Eight (8) page Response under 37 CFR § 1.121;
- (b) Seventy-two (72) page Marked-up Specification;
- (c) Sixty-eight (68) page Clean Specification;
- (d) One (1) page Fee Transmittal;
- (e) One (1) page Transmittal;
- (f) One (1) page Petition for Extension of Time;
- (g) One (1) check #20717 in the amount of \$110.00; and
- (h) One (1) postcard listing the above-noted items (a)-(g).

Applicants have also enclosed a copy of the postcard stamped by the USPTO acknowledging receipt of items (i)-(h) on October 27, 2003 (Exhibit A).

(ii) On April 27, 2004, Tracy U. Palovich (Ms. Palovich), registration no. 47,840, a patent agent authorized to act on behalf of this application, checked the status of this application on the secure access section of the Patent Application Information Retrieval (PAIR) program and noted that a Notice of Non-Compliant Amendment dated November 13, 2003 had been issued (Exhibit B). Prior to April 27, 2004, Applicants had not received a copy of this Notice.

Ms. Palovich obtained a copy of this Notice using the imaged file wrapper on PAIR.

(iii) Upon review of this Notice, Applicants noted that since the Response filed on October 27, 2003 was in response to a Non-Final Office Action, extensions of time from the mailing date of the Notice were available under 37 CFR 1.136(a).

In view thereof, Applicants respectfully request that the enclosed Response to the outstanding Notice addressing the issues set forth therein be entered as being timely submitted. Applicants also respectfully assert that the filing of a Petition for Extension of

Time should not be required since the outstanding Notice had not been received by Applicants prior to April 27, 2004.

However, if the Director rejects this Petition and finds that the filing of a Petition for Extension of Time to respond to the outstanding Notice is required, Applicants respectfully request that the Examiner extend the period for response to the Notice dated November 13, 2003 for five (5) months from December 13, 2003 to May 13, 2004. In compliance with 37 CFR 1.136(a), the Director is hereby authorized to charge the extension fee under 37 CFR § 1.17(a)(4) of \$1480.00, any deficiency in the fees due with the filing of this paper, or credit any overpayment in any fees to our Deposit Account Number 08-3040.

Respectfully submitted,

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Attorneys for Applicants

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MAY 10 2004

EXHIBIT A

TECH CENTER 1600/2900

Serial No. 09/743,818 Doc. No. GHC11USA Atty/Sec CAK/lb Date 10-27-03

Inventor Anthony Steven Weiss

Client GHC

Title Protease Susceptibility II

The following has been received in the US Patent and Trademark Office on the date stamped hereon:

1 pp. Extension of Time
8 pp. Response: OA dtd August 25, 2003
1 pp. Transmittal Letter
1 pp. Fee Transmittal letter
2 pp. Acknowledgement of receipt
72 pp. Marked-up copy of specification
68 pp. Clean copy of specification
Check #**20717** for \$110.00



Respectfully,
HOWSON AND HOWSON

CAK

Express Mail
NO.

EU 531570638 US

RECEIVED

EXHIBIT B

MAY 10 2004

TECH CENTER 1600/2900



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 09/143818

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on _____ is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following omission(s) or provision is required. **Only the section (1.121(h)) of the amendment document containing the omission or non-compliant provision must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.**

THE FOLLOWING CHECKED (X) ELEMENT(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

1. Amendments to the specification:
 A. Amended paragraph(s) do not include markings.
 B. New paragraph(s) should not be underlined.
 C. Other _____

2. Abstract:
 A. Not presented on a separate sheet. 37 CFR 1.72.
 B. Other _____

3. Amendments to the drawings: _____

4. Amendments to the claims:
 A. A complete listing of all of the claims is not present.
 B. The listing of claims does not include the text of all claims (incl. withdrawn claims)
 C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 D. The claims of this amendment paper have not been presented in ascending numerical order.
 E. Other: Claims 1-89

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opia/preonnotice/officenlyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION**, and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection**, and is not affected by the non-compliant status of the amendment.

Legal Instruments Examiner (LIE)